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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/711,435 | 11/13/2000 | Robert Allan Unger | 50P4199 | 7705 |
| 20480 | 7590 | 10/01/2004 | EXAMINER | |
| STEVEN L. NICHOLS RADER, FISHMAN & GRAVER PLLC 10653 S. RIVER FRONT PARKWAY SUITE 150 SOUTH JORDAN, UT 84095 | | | NGUYEN, HUY THANH | |
| | | ART UNIT | | PAPER NUMBER |
| | | 2616 | | |
| DATE MAILED: 10/01/2004 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|------------------------------|------------------------|---------------------|--|
| | 09/711,435 | UNGER, ROBERT ALLAN | |
| Examiner | Art Unit | | |
| HUY T NGUYEN | 2616 | | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 28 June 2004.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-46 and 48-58 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-46 and 48-58 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date .

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ .

5) Notice of Informal Patent Application (PTO-152)

6) Other: ____ .

DETAILED ACTION

1. The art unit assigned to the examiner has been changed from 2615 to **2616**.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 28 June 2004 has been entered.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 23-25, 27, 30, 31, 35, 37, 40, 42, 48, 49, 51, 52, 53, and 55-58 are rejected under 35 U.S.C. 102(e) as being anticipated by Pierre et al (6,678,463).

Regarding claims 23, 30, 42, 51, 52, 55, 56, 57 and 58, Pierre discloses a personal video recorder (Figs. 4-6, column 6) having a user-controlled data capture

function, the recorder comprising: an input (102) for receiving an audiovisual signal and an output for outputting said audiovisual signal; a buffer (90,92) for buffering said audiovisual signal, said buffer retaining a portion of said audiovisual signal after that portion has been output by said recorder (column 5, lines 10-15) ; a data storage unit (105) ; and a processor (10) that receives input from a user input device; wherein, upon receipt of a user command input through said user input device, said processor records a segment of said audiovisual signal in said data storage unit, said segment of said audiovisual signal comprising: a first predetermined amount of said portion of said audiovisual signal retained in said buffer; and a second predetermined amount of said portion of said audiovisual signal output by said recorder after receipt of said user command (column 6, lines 23-36 and 60-68).

Further for claim 23, 40, 42, 49, 51, 55, 57, 58, Pierre further teaches that the first predetermined amount of the first portion and second predetermined amount of the second portion are set by the user input device since after storing the first predetermined amount in the buffer, the user inputs a command to the input device to record the second predetermine amount corresponding to the remaining portion of the program - or until stopping recording command is input by the user (column 6, lines 5-20.

Further for claims 30 and 56, Pierre further teaches processor associates an identifying label with each said segment of said audiovisual signal recorded in said data storage unit (column 5, lines 5-65).

Further for claims 42 and 53, Pierre teaches the use of a remote control device (column 4, lines 45-50).

Regarding claims 27 and 37, Pierre teaches the use of a remote control device (column 4, lines 45-50).

Regarding claims 24, 25 , 31 and 48 , Pierre further teaches processor associates an identifying label with each said segment of said audiovisual signal recorded in said data storage unit (column 5, lines 5-65) .

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Art Unit: 2616

6. Claims 26, 29,36 ,41,50 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pierre et al in view of Kuroda (6,311,011).

Regarding claim 26, 29, 36 and 41, Pierre fails teaches the use of hard disk for storing the segment from the storage . However, it is noted that using a heard disk for storing the signal is well known in the art as taught by Kuroda. Therefore, it would have been obvious to one of ordinary skill in the art to modify Pierre by providing the apparatus of Pierre with a disk driver for receiving a hard disk and storing the segment from the storage device for later user.

7. Claim 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pierre et al in view of JO (5,237,462).

Regarding claim 28, Pierre fails to teach the second predetermined amount is determined by length of time .

Jo teaches recording apparatus having a control means for setting a length of time of a predetermine amount of video signal (Abstract) .

It would have been obvious to one of ordinary sill in the art to modify Pierre with JO by using a control means as taught by JO with the apparatus of Pierre for setting the second predetermine amount by a length of time thereby accurately control the second predetermined amount to be recorded .

8. Claims 32,33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pierre et al in view of Kuroda (6,311,011).

Regarding claims 32,33 and 34 ,Pierre fails to teaches that the label including date stamp and time elapsed for the program . Kuroda teaches a recording apparatus

having a control means for labeling the recorded program with date stamp and time elapses for the program (column 7, lines 50-65)

It would have been obvious to one of ordinary skill in the art to modify Pierre with Kuroda by labeling the recorded program with date stamp and time elapsed information as additional information to identifying the recorded program to be reproduced .

9. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pierre in view of Inoue et al (5,990,881).

Regarding claim 33, Pierre fails to teach adding time elapsed amount to the video-audio signal . Inoue teaches a recording /reproducing apparatus for recording video audio signal having means for adding time elapsed in the video signal (column 5, lines 35-45).

It would have been obvious to one of ordinary skill in the art to modify Pierre with Inoue by adding the elapsed time to the video audio signal of Pierre thereby for easily controlling the running time of the program.

10. Claims 38 , 39,43-46 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pierre in view of Vallone et al (6,642,939).

Regarding claims 38,39 ,43 and 54 , Pierre fails to specifically teach the use of a plurality of remote control units . Vallone teaches using a plurality of remote control devices for different user to control a system for accessing the video signal to be stored and replay (column 16, lines 60 to column 17, lines 25). It would have been obvious to one of ordinary skill in the art to modify Pierre with Vallone by using the teaching of

Vallone for modifying the recorder and remote control of Pierre to provide a plurality remote control devices for controlling to recorder to record the program and accessing the recorded files by different users thereby enhancing the capacity of apparatus of Pierre for used with a plurality of users.

Further for claims 45-46, Pierre as modified with Vallone further teaches the secondary remote control has less function than the main remote control device (column 17, line 15-20).

11. Claims 1, 2-3,5, 9,11-13,17-18,11-13,15,21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pierre et al in view of Lynch et al (5,438,423).

Regarding, claims 1,11 and 17, Pierre discloses a personal video recorder (Figs. 4-6, column 6,) having a user-controlled data capture function, the recorder comprising: an input (102) for receiving an audiovisual signal and an output for outputting said audiovisual signal; a buffer (90,92) for buffering said audiovisual signal, said buffer retaining a portion of said audiovisual signal after that portion has been output by said recorder (column 5, lines 10-15); a data storage unit (105); and a processor (10) that receives input from a user input device; wherein, upon receipt of a user command input through said user input device, said processor records a segment of said audiovisual signal in said data storage unit, said segment of said audiovisual signal comprising: a first predetermined amount of said portion of said audiovisual signal retained in said buffer; and a second predetermined amount of said portion of said audiovisual signal output by said recorder after receipt of said user command (column 6, lines 23-36 and 60-68).

Pierre fails to teach that the first predetermined amount is less than all the portion of the audiovisual signal retained in the buffer .

Lynch teaches a recorder (the figure) having a buffer means for storing the video signal, and a portion of video less than the video signal retained in the buffer is transferred to a storage means for recording thereon (column 3).

It would have been obvious to one of ordinary skill in the art to modify Pierre with Lynch by using a control means as taught by Lynch for transferring a portion of the retained video signal in the buffer thereby enhancing the recorder of Pierre for enabling of selecting a desired portion of the video signal retained in the buffer means for storing with the second predetermined amount when needed .

Regarding claims 2, 3, 12,13, 18, Pierre further teaches the processor associates an identifying label with each said segment of said audiovisual signal recorded in said data storage unit (column 5, lines 5-65).

Regarding claims 5, 19, Pierre teaches the use of a remote control device (column 4, lines 45-50).

Regarding claims 15 and 21, Pierre as modified with Lynch further teaches that the predetermined first portion and second portion amount is set by the user input device since after storing the first predetermined amount in buffer, the user inputs command to input device to record the second predetermined amount corresponding to the remaining portion of the program until stopping recording (column 6, lines 5-20).

Regarding claim 22, Pierre as modified with Lynch further teaches transferring n the segment from the recorder for viewing by a monitor.

12. Claims 4 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pierre et al in view of Lynch as applied to claim 1 above further in view of Kuroda (6,311,011).

Regarding claims 4 and 10, Pierre fails to teach the use of hard disk s for storing the segment from the storage. However, it is noted that using a heard disk for storing the signal is well known in the art as taught by Kuroda. Therefore, it would have been obvious to one of ordinary skill in the art to modify Pierre with Kuroda by providing the apparatus of Pierre with a disk driver for receiving a hard disk and storing the segment from the storage device for later user.

13. Claims 6,7,14 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pierre in view of Lynch as applied to claims 1,5, 11 and 19 above, further in view of Vallone et al (6,642,939).

Regarding claims 6,7,14 and 20, Pierre fails to specifically teach the use of a plurality of remote control units. Vallone teaches using a plurality of remote control devices for different user to control a system for accessing the video signal to be stored and replay (column 16, lines 60 t column 17, lines 25). It would have bee obvious to one of ordinary skill in the art to modify Pierre with Vallone by using the teaching of Vallone for modifying the recorder and remote control of Pierre to provide a plurality remote control devices for controlling to recorder to record the program and accessing the recorded files by different users thereby enhancing the capacity of apparatus of Pierre for used with a plurality of users.

14. Claims 9 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pierre et al in view of Lynch as applied to claims 1 and 11 above, further in view of JO (5,237,462).

Regarding claim 9 and 16, Pierre fails to teach the second predetermined amount is determined by length of time.

Jo teaches a recording apparatus having a control means for setting a length of time for a predetermined amount of video signal (Abstract).

It would have been obvious to one of ordinary skill in the art to modify Pierre with JO by using a control means as taught by JO with the apparatus of Pierre for setting the second predetermined amount by a length of time thereby accurately controlling the second predetermined amount to be recorded.

Response to Arguments

15. Applicant's arguments filed 28 June 2004 have been fully considered but they are not persuasive.

Regarding claim 23, Applicant argues that Pierre does not teach the second portion amount is set by the user after receiving a recording request. In response, the examiner disagrees. It is noted that Pierre teaches that the user can input command for controlling the recording of the first amount and a second amount and the user can stop the recording of the first amount on the buffer and second amount on the storage unit. After receiving the recording command, the second portion is recorded and the user can stop the recording the second portion anytime (column 2,

lines 45-60). Since the first portion amount and second portion amount are generated and formed based on the decision of the user , the first portion and second portion amounts can be set by the user through an user input device.

Regarding claims 30,52 and 56, Applicant argues that Pierre does not teach using information for identifying the segment . In response, the examiner disagrees . It is noted that Pierre teaches that a program that is comprises a first portion and second portion is stored as a file and each file having a unique identifying information used for retrieving the file (column 5, lines 55-65). Pierre further teaches that the segment (file) that comprises a first portion and second portion can be any part of a show and a movie program (column 4, lines 14-40) . It is clearly that Pierre teaches each segment (file) having a label that distinguishes from other taken from a movie program or a show.

Regarding claims 42 and 53, Applicant argues that Pierre does not teach a remote control that has a dedicated remote button to order recording of a segment . In response, the examiner disagrees . It is noted that Pierre teach using a remote control for controlling the recording of segment under command of the user therefore the remote control of Pierre has a recording button using for recording the segment . See Pierre (column 2, line 25-32, column 4, lines 44-45).

Regarding claim 57, applicant argues that "claim 57 recites replaying an audiovisual program that is already stored on the data storage unit of PVR and then capturing segments of that program during replay based an user command and storing separate recording of the capture segment " and " Pierre does not teach or suggest a

method of capturing segments of a program that is being replayed from a PVR own data storage unit as recited in claim 57." In response it is noted that the applicant argument does not recited in claim 57. It is noted that claim 57 does not clearly recites capturing a segment of a program that is being replayed from PVR storage unit.

Regarding claim 1, Applicant argues that Lynch fails to teach that a portion that is less than all portion of the audiovisual signal retained in a buffer (dynamic buffer) is transferred to a storage unit. In response the examiner disagrees. It is noted that Lynch teaches a portion of video/audio signal selected from video /audio signal retained in the buffer is stored in the static buffer and the selected video/audio portion is less than all the portion of retained audio/video in the dynamic buffer is transferred to the storage device. It is clear that Lynch teaches a portion of video signal that is less than all of portion of the audiovisual signal retained in the buffer is transfer to a storage device. Therefore the combination of Pierre and Lynch further teaches means for transferring a fist predetermined amount less than all portion of the audiovisual signal retained in the buffer to the storage unit.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lang teaches recorder that has storage unit for storing a replay.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUY T NGUYEN whose telephone number is (703) 305-4775. The examiner can normally be reached on 8:30AM -6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, acting, Thai Tran can be reached on (703) 305-4725. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

H.N


HUY T. NGUYEN
PRIMARY EXAMINER